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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/971,903 11/17/97 HARUKI

H 826.1431/JDH

EXAMINER

TM01/1129

STAAS & HALSEY
SUITE 500
700 ELEVENTH STREET N W
WASHINGTON DC 20001

MYHRE, J

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

11/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/971,903

Applicant(s)
Haruki et al

Examiner
James Myhre

Group Art Unit
2162

☒ Responsive to communication(s) filed on Sep 19, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendment

1. The amendment filed on September 19, 2000 has been considered but is ineffective to overcome the Hill (5,761,649) and Peschel, Joe, (*Infoworld*) references.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (5,761,649) in view of Peschel, Joe, *InfoWorld* and Bisson, Giselle, *M2Presswire*.

Claims 1, 10-13, 16, and 17: Hill discloses a system and method for registering and updating software on a remote computer, comprising:

- a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 4, lines 22-40 and col 5, lines 57-67); and

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b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 4, lines 9-21 and col 5, lines 51-57).

Hill further discloses the user registration information containing an identification number of each user (col 13, lines 40-43) and product information, such as version update (revision level)(col 13, lines 46-51). Hill also discloses extracting information (support files) about the products and transmitting the information to the user (col 14, lines 40-56) upon user request. Thus, Hill discloses the user requesting either an update or support files (Applicant's "requested information type").

The Examiner considers the support files disclosed by Hill as the equivalent of the claimed "products which can be used in combination with products that are used by the users".

Furthermore, Peschel discusses a software application called *Oil Change* from CyberMedia Inc. which automatically updates applications and drivers on a user's computer by connecting to a centralized external database. Again, the Examiner considers the drivers as products used in combination with products on the user's system. This feature of *Oil Change* is further discussed by Bisson, Giselle of CyberMedia in a January 9, 1997 article which states that "If *Oil Change* notices a missing or outdated driver, it notifies the user, and with permission, downloads and installs it automatically. The customized version of *Oil Change* will update the drivers for all of the peripherals and components in the Sony PC, as well as Sony-specific software" (page 14). Thus, *Oil Change* not only identifies missing or outdated products (drivers) associated with

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products used on the user's system, but also notifies the user of this information and lets the user decide whether or not to allow *Oil Change* to download the new product.

However, while Hill discloses providing software updates or support files to a user either automatically or upon receipt of a request from the user, Hill does not explicitly disclose storing the requesting information type as part of the registration information. Official Notice is taken that it is old and well known within the computer arts to maintain user preference data and to use this user preference data to filter information transmitted to the user. The stored user preferences are commonly used by marketers to present targeted advertisements, by autonomous browsers (agents) to forward information about new products and services, by email service providers to eliminate unwanted or inappropriate information (such as adult material to a minor's account), etc. Moreover, most software vendors offer a wide variety of software types and oftentimes multiple software titles of the same software type (word processors, for example). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a parameter within the client's registration information indicating the type of information preferred by the user. One would have been motivated to include user preference information in order to give the user better control over the amount and content of information received.

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Claim 2: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 1 above, and Hill further discloses means for the user to request new information about a product from the general management means (col 5, lines 4-30).

Claim 3: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Hill further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 4, lines 11-15; col 5, lines 30-36; and col 9, lines 46-48).

Claim 4: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Hill further discloses:

- a. A personal identification number as part of the registration information (col 4, lines 15-31); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 3, lines 9-31).

Claims 5 and 6: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, but do not explicitly disclose basing the automatic update of the software on the number of times the application had been accessed. Official notice is taken that it is old and well known within the technological art to conduct periodic checks of software and that these checks could be based on a time limit or a maximum number of uses. An example of using the usage number in the industry is the "demo"

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software programs available from vendors. A demo is normally able to be used for a limited number of times, after which it either erases itself, prevents the user from activating the program, or it merely notifies the user that the “free use” period has expired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check the software applications being tracked by Hill’s invention and that these checks could be based on usage or time. One would have been motivated to track them by the number of times the software had been used in order to minimize the number of updates by ensuring the software with the highest usage level is always at the most up-to-date status possible and the software which is seldom used is only updated when it needs to be used.

Claims 7, 8, 14, 15, and 18-20: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, but Hill does not explicitly disclose multiple vendors updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user. Peschel further discusses allowing vendors (companies) to directly update the information about their products in the database (page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Hill’s general management means’ database by connecting to one or more external vendors and to allow them to update their product’s information. One would have been motivated to do this in order to increase the number of software products that Hill’s system could update and to ensure that the database contained the latest information available from each vendor as discussed by Peschel.

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Claim 9: Hill, Peschel, and Bisson disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Peschel and Bisson discuss *Oil Change* which allows vendors to update the centralized database. Peschel further discusses *Oil Change* using a database which contains the information about the latest versions of products, but which connects the user to the vendor's system to actually download the complete "fix" or update (using Yellow Pages)(Page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include links to vendors in the database. One would have been motivated to include links to the vendors in order to decrease the size of the database, thus increasing the efficiency and speed by which the system could respond to an inquiry from a user.

Response to Arguments

4. Applicant's arguments filed September 19, 2000 have been fully considered but they are not persuasive.

a. Applicant's arguments pertaining to the rejection of Claims 1-6, 10-13, and 16-17 under 35 U.S.C. 103 as being unpatentable over Hill have been considered but are moot in view of the new ground(s) of rejection. The feature of including "information about products which can be used in combination with products that are used by users" has been discussed in paragraph 3 above.

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b. Applicant's arguments pertaining to the rejection of Claims 7-9, 14-15, and 18-20 under 35 U.S.C. 103 as being unpatentable over Hill in view of Peschel have been considered but are moot in view of the new ground(s) of rejection of Claims 1-6, 10-13, and 16-17 as discussed above.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:00 a.m. to 3:30 p.m.

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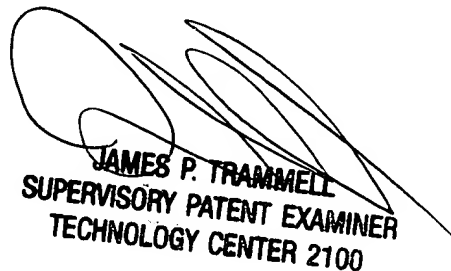
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703) 305-9768. The fax phone number for Formal or Official faxes to Technology Center 2100 is (703) 308-9051 or 9052. Draft or informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-3900.



JWM
November 27, 2000



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100